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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,635

12/12/2003

Krisztian Kiss

59643.00280

1642

32294

7590

09/25/2008

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

NOORISTANY, SULAIMAN

ART UNIT

PAPER NUMBER

2146

MAIL DATE

DELIVERY MODE

09/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/733,635	Applicant(s) KISS ET AL.	
	Examiner SULAIMAN NOORISTANY	Art Unit 2146	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-11,16,17 and 20-22 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,4-11,16,17 and 20-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/29/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

Detailed Action

This Office Action is response to the application (10/733635) filed on 12, Dec 2003

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/18/08 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-11, 16-17 & 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 10-11, 16-17 & 20 recite "*controller entity*" which is directed at a computer program.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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Claims 1, 4-11, 16-17 & 20-22 are rejected under 112, second paragraph as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention

Claim 1, “request is to be *forked in parallel or sequentially*” in line 8 is indefinite and not clear what this is in reference to. However the claim will be given a broad reasonable interpretation for the purposes of examination as best understood.

Claims 10-11, 17, 20 & 22 are rejected for similar reasons as stated for claim 1.

Claim 17, “A user information storage” in line 8 is indefinite and not clear what this is in reference to (e.g. is it same as computer storage medium?). However the claim will be given a broad reasonable interpretation for the purposes of examination as best understood

Claim 20, “*registration means*”, “*interface means*” & “*query means*” is indefinite and not clear what this is in reference to. However the claim will be given a broad reasonable interpretation for the purposes of examination as best understood.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 1, 4-11, 16-17 & 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Herrero**. U.S. Patent No. **US 7,177,642** in view of **Requena** U.S Patent No. **US 7028101**.

Regarding claim 1, Herrero teaches wherein a method comprising:

registering in a controller entity a plurality of contact addresses for a user (**The specification of SIP (RFC-2543) already allows a given user to indicate in a registration message REGISTER multiple contact points where said user can be contacted – Col. 4, lines 40-42; Fig. 6 – USER-1 –USER-N**);

receiving a request at the controller entity for a communication link to the user (**user can receive incoming sessions (e.g.: voice calls) on his/her terminal from other users that have “dialed” the public ID -- Col. 2, lines 5-7**);

querying (**I-CSCF**) by the control entity a database for information (**storage means containing SD of a plurality of users**) regarding a manner regarding how to handle the request (**Once said registration request REGISTER arrives to the I-CSCF, in step 3 a query is made to the HSS to determine the user registration status – Col. 10, lines 41-43**) and;

processing the request in accordance with the information from the database (**an automatic process performed by the application running in the UE, wherein said data are extracted (by a request) from the USIM (storage) – Col. 10, lines 27-29**).

With respect to claim 1, Herrero is silent in terms of “*said information indicating if said request is to be forked in parallel or sequentially*”

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Requena teaches that is well known to utilize information indicating if said request is to be forked in parallel or sequentially **(the OLS may determine whether to convert "im:" into "sip:" or "vv:" before forwarding the message to the destination network. This may be performed sequentially, in parallel, or using both sequential and parallel operations – Col. 13, lines 28-32; Fig. 6, unit 610 -- the OLS can sequentially and/or simultaneously send multiple outgoing messages, one for each of the multiple addresses).**

It would have been obvious to one ordinary skill in the art to modify's Herrero's invention to offers other advantages over the prior art approaches. In addition, in routing SIP messages through a UMTS or other SIP-enabled network, location services such as DNS or ENUM are typically using DNS or ENUM queries for obtaining the address of the next hop SIP server. This function is often implemented in the Serving-CSCF (S-CSCF) according to 3GPP terminology and specifications. Once-the message is forwarded to the next hop in the destination network, the message is sent to the Interrogating-CSCF (I-CSCF) that will take care of finding where the user is located within the local domain. However, SIP and other protocols may support multiple address schemes to be included in the messages, such as SIP, secure SIP, telephony, instant messaging, presence, etc. The determination of which hop is the next hop in the transmission of the message may be difficult, particularly where the location service provided multiple possible address schemes in response to a query, as taught by Requena (Col. 1-2).

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Regarding claim 4, Herrero and Requena together taught the method as in claim 1 above. Herrero further teaches wherein the registering comprises registering the plurality of contact addresses for the user in the controller entity which is provided in association with a multimedia network” **(Fig. 6, Subscriber Data (SD) register)**.

Regarding claim 5, Herrero and Requena together taught the method as in claim 1 above. Herrero further teaches wherein the registering comprises the user registering the plurality of contact addresses in at least two different communication networks **(Method for supporting multiple registration from the same user requested from different terminals in a telecommunications system --Abstract, lines 1-3) .**

Regarding claim 6, Herrero and Requena together taught the method as in claim 1 above. Herrero further teaches wherein the processing occurs in accordance with the information from the database if no user preference has been indicated for the known contact addresses **(an automatic process performed by the application running in the UE, wherein said data are extracted from the USIM containing in said UE -- Col. 10, lines 27-29).**

Regarding claim 7, Herrero and Requena together taught the method as in claim 1 above. Herrero further teaches wherein the querying comprises applying a query to a sub-group of the known contact addresses **(Fig. 1 (Public user identity 1 (e.g.: SIP**

URL), Public user identity 2 (e.g.: E.164), Public user identity 3).

Regarding claim 8, Herrero and Requena together taught the method as in claim 1 above, as described above. Herrero further teaches wherein indicating and assigning handling instructions for at least one contact address independently during registration of the at least one contact address (**Fig. 5 -- UE1-UE3 indicates how the users are registering through the IMS network as well as handling instruction for at least one contact address**).

Regarding claim 9, Herrero and Requena together taught the method as in claim 1 above. Herrero further teaches wherein the indicating and assigning comprises indicating and handling the handling instructions for the at least one contact address by either the user or the database (**Fig. 5 -- UE1-UE3 indicates how the users are registering through the IMS network as well as handling instruction for at least one contact address**).

Regarding claim 10, Herrero teaches wherein a system comprising:

a multimedia network (**Internet Protocol Multimedia Subsystem (IMS) --Col. 7, line 66**) provided with a controller entity (**Fig. 5**) configured to register contact addresses of a user (**Fig. 6, (USER-N)**); and

a database configured to store information (**storage means containing SD of a plurality of users**) regarding a manner regarding how to handle a request for the user

(Once said registration request REGISTER arrives to the I-CSCF, in step 3 a query is made to the HSS to determine the user registration status – Col. 10, lines 41-43),

wherein the controller entity is configured to query the user information storage and configured to process requests for connections to the user in accordance with the information queried from the database **(an automatic process performed by the application running in the UE, wherein said data are extracted (by a request) from the USIM (storage) – Col. 10, lines 27-29).**

With respect to claim 10, Herrero is silent in terms of “*said information indicating if said request is to be forked in parallel or sequentially*”

Requena teaches that is well known to utilize information indicating if said request is to be forked in parallel or sequentially **(the OLS may determine whether to convert "im:" into "sip:" or "vv:" before forwarding the message to the destination network. This may be performed sequentially, in parallel, or using both sequential and parallel operations – Col. 13, lines 28-32; Fig. 6, unit 610 -- the OLS can sequentially and/or simultaneously send multiple outgoing messages, one for each of the multiple addresses).**

It would have been obvious to one ordinary skill in the art to modify's Herrero's invention to offers other advantages over the prior art approaches. In addition, in routing SIP messages through a UMTS or other SIP-enabled network, location services such as DNS or ENUM are typically using DNS or ENUM queries for obtaining the address of the next hop SIP server. This function is often implemented in the Serving-CSCF (S-

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CSCF) according to 3GPP terminology and specifications. Once the message is forwarded to the next hop in the destination network, the message is sent to the Interrogating-CSCF (I-CSCF) that will take care of finding where the user is located within the local domain. However, SIP and other protocols may support multiple address schemes to be included in the messages, such as SIP, secure SIP, telephony, instant messaging, presence, etc. The determination of which hop is the next hop in the transmission of the message may be difficult, particularly where the location service provided multiple possible address schemes in response to a query, as taught by Requena (Col. 1-2).

Claims 11, 17, 20 & 22 have the similar limitation as those claims 1 & 10; therefore, it's rejected under the same rationale as in claim 1 & 10.

Claim 16 has the similar limitation as of claim 6; therefore, it's rejected under the same rationale as in claim 6.

Regarding claim 21, Herrero and Requena together taught the method as in claim 1 above. Herrero further teaches wherein said querying comprises querying the database in use information storage which stores a user profile (**Said query comprises both data: the public-ID and private -ID received in the REGISTER, and will be used by the HSS to find out the corresponding SD register of said user -- Col. 10, lines 43-46; Fig. 3 (USER-N, OTHER DATA (User profile data)).**

Response to Amendment

Applicant's arguments with respect to claim(s) 1, 4-11, 16-17 & 20-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sulaiman Nooristany whose telephone number is (571) 270-1929. The examiner can normally be reached on M-F from 9 to 5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Pwu, can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

Sulaiman Nooristany 09/16/2008

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2146